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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/758,242 Confirmation No. : 5321  
First Named Inventor : Bernd SUNDERMANN  
Filed : January 16, 2004  
TC/A.U. : 1621  
Examiner : Brian J. Davis  
  
Docket No. : 029310.53136US  
Customer No. : 23911  
  
Title : Substituted 4-Aminocyclohexanols

REPLY TO OFFICE ACTION

**Mail Stop AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a response to the Office Action mailed September 23, 2005 in the above-identified patent application.

Responsive to the requirement for restriction, Applicants hereby elect the claims of Group I, namely, compound and composition claims 1-11 and 125-148, for examination in the instant application.

Furthermore, in response to the Examiner's invitation to elect an additional group of claims to be examined with the compound and composition claims, Applicants hereby further elect the claims of Group II, namely, method of use claims 149 and 150, which are directed to the use of the claimed compounds and/or compositions. As acknowledged by the Examiner, the use, as claimed, cannot be practiced with a materially different product.

The foregoing election is made with traverse. The Office Action attempts to justify the restriction between the use claims of Group II and the synthesis claims of Group III by a gratuitous assertion that the product claims are not allowable. However, no basis whatever for this conclusion is set forth in the office action. This is improper. A proper explanation of reasons is required for

any such conclusion. 35 U.S.C. §132(a). In the absence of any statement of the reasons for this conclusion, the attempted restriction is not properly justified, and reconsideration and withdrawal thereof are respectfully requested.

Responsive to the requirement for election of species, Applicants hereby elect the species of Example 4, namely 4-dimethylamino-1-phenethyl-4-phenylcyclohexanol, in which R1 and R2 each represent methyl, R3 represents phenyl, and R4 represents phenethyl. Inasmuch as the Applicants agree with the Examiner that the respective species are patentably distinct, this election of species is made without traverse.

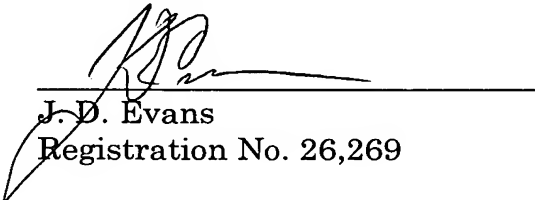
Prompt, favorable action on the application, including synthesis claims 151-161, is earnestly solicited.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 029310.53136US).

Respectfully submitted,

October 6, 2005



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